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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 927,462	08 13 2001	Charles E. Schwarz JR.	47004.000142	4155

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EXAMINER

PAIK, STEVE S

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12 24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,462

Applicant(s)

SCHWARZ, CHARLES E.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6                      6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claim 14 is objected to because of the following informalities: the word "an" in line 2 appears to be -- a --. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 11-14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson, Jr. (USP 6,078,888).

Regarding claim 1, Johnson, Jr. discloses a system and a method for attributing reward to a collective account comprising:

associating a plurality of tags (A customer may use a tag issued in many different forms as shown 100 in Fig. 1) with at least one collective account (tag issuer's account);

aggregating tag usage (such as purchasing gas, goods or services) for at least one tag associated with at least one collective account;

calculating a reward based on the aggregate tag usage (col. 2, lines 33-37); and

attributing the reward to at least one collective account (col. 4, lines 30-38).

Regarding claims 2 and 19, Johnson, Jr. discloses the system and the method as recited in rejected claim 1 stated above, where at least one tag is held by at least one tag holder who is a member of at least one organization, and where the at least one organization is the holder of at

Art Unit: 2876

least one collective account. As the Background of the Invention section of Johnson et al. reference teaches, the tag transponder technology is used in many areas of technology relating to vehicles. Such technology is used in tracking vehicles, navigational aids, toll collection, diagnostics, vehicle security and theft deterrence, keyless entry, refueling, collision avoidance, vehicle identification, surveillance and traffic control as well as transmitting and receiving financial data. In a situation where the tag transponder is used as a part of a refueling system, the host network (300 in Fig. 1) can be considered as one organization which holds the at least one collective account and a person who holds the tag (100) having any form of the disclosed tag transponders is a member (customer) of the at least one organization.

Regarding claim 11, Johnson, Jr. discloses the system and the method as recited in rejected claim 1 stated above, where at least one tags comprises at least one communication port (I/O port 124 in Fig. 2A) allowing the at least one of the tags to communicate with other devices.

Regarding claim 12, Johnson, Jr. discloses the system and the method as recited in rejected claim 1 stated above, where at least one tags comprises a microprocessor (116 communication controller in Fig. 2a).

Regarding claim 13, Johnson, Jr. discloses the system and the method as recited in rejected claim 1 stated above, where at least one tags comprises a transmitter (106 transmitter in Fig. 2a).

Regarding claim 14, Johnson, Jr. discloses the system and the method as recited in rejected claim 1 stated above, where the plurality of tags further comprises at least one of a smart card, a bar coded sticker, a transponder (100) readable by a reader/antenna (110 or 112) or combinations thereof.

Art Unit: 2876

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-8, 20-25 and 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (USP 6,078,888) in view of Hovakimian (USP 5,466,919).

Regarding claims 3-8 and 20-25, Johnson, Jr. teaches a method for attributing a reward to collective account that comprises the steps of associating a plurality of tags (A customer may use a tag issued in many different forms as shown 100 in Fig. 1) with at least one collective account (tag issuer's account), aggregating tag usage (such as purchasing gas, goods or services) for at least one tag associated with at least one collective account, calculating a reward based on the aggregate tag usage (col. 2, lines 33-37), and attributing the reward to at least one collective account (col. 4, lines 30-38). Although, Johnson, Jr. discloses the tag transponder technology can be used in tracking vehicles, navigational aids, toll collection, diagnostics, vehicle security and theft deterrence, keyless entry, refueling, collision avoidance, vehicle identification, surveillance and traffic control as well as transmitting and receiving financial data, he fails to specifically disclose the collective account comprises a charitable account.

Hovakimian discloses a method which enables a credit card holder to make a donation to a cardholder-selected charity any time he makes a purchase using the credit card (col. 1, lines 44-47). The cardholder can verify the donated amount when he receives his statement (billing 110

Art Unit: 2876

and col. 3, lines 29-32). The transactions will be aggregated and calculated electronically as they occur and the card holder is allowed to make changes to his donor instructions. This undoubtedly includes the amount and interval he intends to donate to his choice of charities. The bank expedited charity donation (abbreviated to BAX with a BAX symbol) system allows the cardholder to make automatic donation and the charities to receive donation in an expedited and accurate method.

In view of Hovakimian's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ the bank expedited charity donation system (BAX) in addition to the tag transponder of Johnson, Jr. due to the fact that a card (tag) holder can have more choices in using his rewards such as loyalty points, airline mileages or cash rebate in accordance with his intension. The BAX system definitely allows the cardholder with more freedom to use his rewards earned by aggregated usages of a credit card or a tag linked to the credit card. Furthermore, such modification of employing the BAX system to the teachings of Johnson, Jr. would have been an obvious matter of usage variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Regarding claims 26-35, Johnson, Jr. teaches a method for attributing a reward to collective account that comprises the steps of associating a plurality of tags (A customer may use a tag issued in many different forms as shown 100 in Fig. 1) with at least one collective account (tag issuer's account), aggregating tag usage (such as purchasing gas, goods or services) for at least one tag associated with at least one collective account (credit card or smart card linked to the tag or transponder, calculating a reward based on the aggregate tag usage (col. 2, lines 33-37), attributing the reward to at least one collective account (col. 4, lines 30-38). Although,

Art Unit: 2876

Johnson, Jr. discloses the tag transponder system can be used in tracking vehicles, navigational aids, toll collection, diagnostics, vehicle security and theft deterrence, keyless entry, refueling, collision avoidance, vehicle identification, surveillance and traffic control as well as transmitting and receiving financial data, he fails to specifically disclose the collective account comprises a charitable account.

Hovakimian discloses a method which enables a credit card holder to make a donation to a cardholder selected charity any time he makes a purchase within pre-approved credit limit using the credit card (col. 1, lines 44-47). The cardholder can verify the donated amount when he receives his statement (billing 110 and col. 3, lines 29-32). The transactions will be aggregated and calculated electronically as they occur and the card holder is allowed to make changes to his donor instructions. This undoubtedly includes the amount and interval he intends to donate to his choice of charities. The bank expedited charity donation (abbreviated to BAX with a BAX symbol) system allows the cardholder to make automatic donation (the amount is calculated at the end of billing statement and the reward can be posted between the end of the billing period and the next billing period) and the charities to receive donation in an expedited and accurate method.

In view of Hovakimian's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ the bank expedited charity donation system (BAX) in addition to the tag transponder of Johnson, Jr. due to the fact that a card (tag) holder can have more choices in using his rewards such as loyalty points, airline mileages or cash rebate in accordance with his intension. The BAX system definitely allows the cardholder with more freedom to allocate and contribute his rewards earned by aggregated

Art Unit: 2876

usages of a credit card or a tag linked to the credit card. Furthermore, such modification of employing the BAX system to the teachings of Johnson, Jr. would have been an obvious matter of usage variation, well within the ordinary skill in the art, and therefore an obvious expedient.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (USP 6,078,888) in view of Akiyama et al. (USP 5,745,049).

Regarding claims 9 and 10, the teachings of Johnson, Jr. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags. Although, Johnson, Jr. discloses the tag transponder, he does not disclose the tags comprises an LED, and LCD.

Akiyama et al. discloses a tag (transponder 201d in Fig. 8) comprises, among other things, a display (66) using LED or the like and an LCD can be used to show the status, such as "normal condition" or "abnormal condition", etc (col. 10, lines 15-32). It is necessary to have a display means to show a status or data communication in a transponder system. Some of the systems integrate with a reader or interrogator including a display device.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have substituted the tag disclosed in Johnson, Jr. reference with a tag disclosed in Akiyama et al. reference since it is an obvious matter of design choice available in the art to design a transponder with a display using an LED and/or LCD. The desired function of displaying a data communication result or status can be achieved in both methods.

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (USP 6,078,888) in view of Ricci et al. (USP 6,463,039).



Regarding claims 15 and 16, the teachings of Johnson, Jr. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags. Although, Johnson, Jr. discloses the tag transponder, he does not specifically disclose the tags comprises a mode of the tags being operated.

Ricci et al. discloses a tag (col. 5, ll. 50-57) operates in a full-duplex communications mode. The full-duplex mode allows the transponder to share a communication channel simultaneously with the interrogator. This obviously increase the amount of data transmitted and received and shortens the time required to exchange data. A transponder is inherently comprised a half-duplex mode communication type.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the tag capable of processing a full duplex mode as taught by Ricci et al. for the purpose of increasing amount of data exchanged using the same amount of time. Since both a half duplex and a full duplex mode are known in the art, it is an obvious matter of selecting a required mode according to the specific needs of a user. If a user is interested in increasing communication speed, then he or she will obviously choose a full duplex mode.

8. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (USP 6,078,888) in view of Khan et al. (USP 6,263,316).

Regarding claims 17 and 18, the teachings of Johnson, Jr. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags. Although, Johnson, Jr. discloses the tag transponder, he does not specifically disclose the tags comprises a sound generating device.

Art Unit: 2876

Khan et al. discloses a transponder (31 in Fig. 3) comprises a sound generating device (39 speaker) for the purpose of alerting its user by generating an audible tone or message.

Furthermore, the audible tone or message can be shown via a display screen (34 and col. 3, lines 49-60).

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the tag capable of generating an audible tone or message along with a visual message to inform its user the result of data communication, as taught by Khan, in addition to the tag (transponder) of Johnson, Jr. for the purpose of informing a tag holder about the status of data read by a reader with both audible and visible signal. Accordingly, the tag holder is better informed of current status and more ready to take the next step to complete his intended transactions using the tag and its reader.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vega et al. (USP 6,265,977) discloses a radio frequency identification tag (RFID tag) comprises a processor, memory and communication interfaces.

Walker et al. (USP 6,128,599) discloses an apparatus for providing and managing a customized reward offer to an affinity group sponsor based on the aggregate performance of members of the group. The apparatus comprises a processor configured to access historical aggregate data and to determine a performance target associated with the affinity group.

Art Unit: 2876

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6893 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

*Steven S. Paik*

Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
December 17, 2002

  
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